

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-20 are presently active in this case, Claims 1, 8-11, 13, 17, and 20 having been amended by way of the present Amendment.

In the outstanding Official Action, Claims 1, 2, 5-8, and 11-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Onodera et al. (U.S. Patent No. 6,298,778) in view of Schwöpfinger (U.S. Patent No. 5,320,042) and further in view of Marentes et al. (U.S. Patent No. 5,488,467). Claims 3, 4, 9, and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Onodera et al. in view of Schwöpfinger and Marentes et al. and further in view of Kon (JP 58002146A). For the reasons discussed below, the Applicants request the withdrawal of the obviousness rejections.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicants submit that a *prima facie* case of obviousness cannot be established in the present case because (1) the references, either when taken singularly or in combination, do not teach or suggest all of the claim limitations, and

(2) there is no suggestion or motivation to modify or combine the references to arrive at the present invention.

Claim 1 of the present application recites a duplex stencil printer comprising, among other features, a cam member and a registration roller pair including a first roller disposed on a lever and a second roller provided with a highly oil-repellent surface, where the second roller is configured to contact a surface of the recording medium that is opposite to a surface of the recording medium that contacts a print drum during a pass of the recording medium through the printer. Claim 8 recites a duplex stencil printer comprising, among other features, a first roller of a registration roller pair is provided with a highly oil-repellent surface, and a second roller of the registration roller pair is configured to contact a surface of the recording medium that is opposite to a surface of the recording medium that contacts a print drum during a pass of the recording medium through the printer. Claim 20 recites a duplex stencil printer comprising, among other features, first and second rollers to deliver the recording medium to a pressing member, where the second roller is configured to contact a surface of the recording medium that is opposite to a surface of the recording medium that contacts a print drum during a pass of the recording medium through the printer.

The Onodera et al. reference describes a sheet feeding device for a stencil printer. The printer includes an ink drum (1), a press drum (20), an upper registration roller (33a), and a lower registration roller (33b). However, as noted in the Official Action, the Onodera et al. reference does not disclose a surface provided with a highly oil-repellent surface. Thus, the Onodera et al. reference clearly does not disclose lower registration roller (33b), which is

configured to contact a surface of a sheet of paper opposite to a surface contacted by the ink drum (1). Additionally, the Onodera et al. reference does not disclose a duplex printer.

The Schwöpfinger reference is cited for the teaching of a roller surface provided with an oil-repellent material. The Schwöpfinger reference describes a paper web guide roller used to guide a freshly printed paper web. The Schwöpfinger reference does not discuss the use of such a roller in a duplex printer. Nor does the Schwöpfinger reference describe the use of such a roller as a registration roller for a print drum. Such a use would not be suggested by the combination of the Onodera et al. reference and the Schwöpfinger reference, since there would be no suggestion or need to use an oil-repellant material on lower registration roller (33b), since roller (33b) does not guide freshly printed paper web because it is upstream of the printing. Thus, based on the combination of the Onodera et al. reference and the Schwöpfinger reference, there is no teaching or suggestion of a registration roller provided with a highly oil-repellent surface, absent hindsight reconstruction of the present invention.

Furthermore, the Marentes et al. reference is cited for the teaching of a cam and lever configuration. However, the Marentes et al. reference also does not teach a registration roller provided with a highly oil-repellent surface. Also, the Marentes et al. reference does not disclose a duplex printer. Thus, the combination of the Onodera et al. reference, the Schwöpfinger reference, and the Marentes et al. reference does not teach or suggest a registration roller provided with a highly oil-repellent surface, absent hindsight reconstruction of the present invention.

As mentioned above, none of the cited reference teaches a duplex printer, and thus no motivation is provided for a roller that is configured to contact a surface of a recording medium opposite to a surface contacted by a print drum, that is provided with a highly oil-repellant surface.

It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicant's structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Accordingly, the Applicants respectfully request the withdrawal of the obviousness rejection of independent Claims 1, 8, and 20.

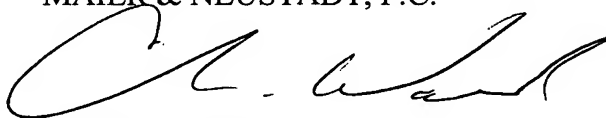
The dependent claims are considered allowable for the reasons advanced for the independent claims from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of their respective independent claim.

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Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record

Christopher D. Ward
Registration No. 41,367

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/01)

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